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EXAMINER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES EDWARD CHRISTENSEN, PETER K. MALKIN, LEWIS ALEXANDER MORROW, JOHN T. RICHARDS and RHONDA ROSENBAUM

Appeal 2009-006839
Application 10/036,194
Technology Center 2400

Before JAMES D. THOMAS, LANCE LEONARD BARRY, and CAROLYN D. THOMAS, *Administrative Patent Judges.*

C. THOMAS, *Administrative Patent Judge.*

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-21, 23 and 41. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

According to Appellants, the invention "relates to a system and method for controlled distribution of information" (Spec. 1, ll. 7-8). More specifically, the invention "provides for access to an electronic profile of a first client to a second client" (Spec., Abstract).

Claim 1 is illustrative:

> 1. A method for providing access to an electronic profile of a first client to a second client comprising the steps of:
>
> creating a network accessible electronic profile of the first client, wherein the electronic profile is accessible by an active object, wherein the active object is bound to the electronic profile;
>
> defining an access right of the second client, wherein the access right determines a portion of the electronic profile accessible to the second client via the active object;
>
> verifying an identity of the second client; and
>
> providing access to the portion electronic profile to the second client via the active object, wherein the active object is transferred to the second client from the first client.

Rejections

R1: Claims 1-21 and 23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Engstrom (US 2002/0138286 A1, Sep. 26, 2002).

R2: Claim 41 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Engstrom and Bhoj (US 6,304,892 B1, Oct. 16, 2001).

FINDINGS OF FACT (FF)

Engstrom Reference

1. Engstrom discloses:

> Accordingly, it is possible for user 117 associated with client 114 to browse content pages 122 of content provider 102 without content provider 102 ascertaining the identity of user 117 .... Although content provider 102 is able to 'see' proxy server 104, content provider 102 will nonetheless not be able to identify user 117 and/or client 114. Unfortunately, when accessing content pages 122 of content provider 102, user 117 may nonetheless be required to submit personally identifiable information to content provider 102 or to a third party agent, thereby defeating at least one of the purposes of proxy server 104. (para. [0023]).

2. Engstrom discloses:

> Therefore, by equipping proxy server 104 with personality profile service 125 in accordance with the teachings of the present invention, user 117 is provided with the ability to access content pages 122 and even register with content provider 102 without the need to disclose personally identifiable information to content provider 102. (para. [0023]).

PRINCIPLES OF LAW

Anticipation

"[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim . . . ." *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986).

ANALYSIS

Claims 1-21, 23 and 41

Issue 1: Did the Examiner err in finding the prior art teaches "verifying an identity of the second client," as set forth in claim 1?

Our representative claim, claim 1 recites, *inter alia*, *"verifying an identity of the second client."* Independent claim 23 recites a similar limitation. Thus, the scope of each of the independent claims includes verifying an identity of a client.

Appellants argue that "nowhere does Engstrom teach that an identity is verified, be that of the client or the content provider" (App. Br. 7) (emphasis omitted). Further, Appellants contend that "Engstrom's method conceals an identity of the client by providing incomplete or random information to the content provider (see for example, paragraphs [0005] and

[0043]), rendering any verification of identity unworkable (App. Br. 7) (emphasis omitted). We agree with Appellants.

Here, the Examiner cites paragraph 23 of Engstrom for teaching "verifying an identity of the second client," as recited in claim 1 (*see* Ans. 3 and 10). Specifically, the Examiner finds that Engstrom's disclosure of the need to submit personally identifiable information to content provider for registering with content provider "is consistent with the alleged limitation of 'verifying an identity of the second client'" (Ans. 3). We disagree.

For instance, the Examiner cites paragraph 23 for teaching the above-noted limitation of claim 1. However, we find that the Examiner has not shown where/how the cited portion of Engstrom discloses "verifying the identity" of a client. While Engstrom discloses that a "user 117 may ... be required to submit personally identifiable information" (FF 1) and that "a user 117 is provided with the ability to ... register with content provider 102" (FF 2), this is merely the recording of personal information, not verifying an identity. Verification implies that a user has presented some information pertaining to the user and based on the information presented, the identify of the user is confirmed (*i.e.*, verified).

Since we agree with at least one of the arguments advanced by Appellants, we need not reach the merits of Appellants' other arguments. It follows that Appellants have shown that the Examiner erred in finding that Engstrom renders claims 1-21, 23, and 41 unpatentable.

Thus, we find that the Examiner has erred in finding that Engstrom teaches "verifying an identity of the second client," as set forth in representative claim 1. Independent claim 23 is commensurate in scope with

claim 1. Accordingly, we reverse the Examiner's §102(e) rejection of independent claims 1 and 23, and claims 2-21 which stand therewith.

The Examiner rejected claim 41 under §103(a). However, claim 41 depends from independent claim 1. Accordingly, we, likewise, reverse the Examiner's rejection of claim 41.

DECISION

The Examiner's rejection of claims 1-21 and 23 under 35 U.S.C. § 102(e) is reversed.

The Examiner's rejection of claim 41 under 35 U.S.C. § 103(a) is reversed.

REVERSED

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